



PATENT
Customer No. 22,852
Attorney Docket No. 07040.0054-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Riccardo CESARINI et al.)
Application Serial No.: 10/679,357) Group Art Unit: 1733
Filed: October 7, 2003) Examiner: Maki, Steven D.
For: HIGH PERFORMANCE TIRE) Confirmation No.: 3867
FOR VEHICLES)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, this is a Reply Brief to the Examiner's Answer mailed March 19, 2008 ("Answer"), which has a two-month period for reply extending through May 19, 2008. A Request for Oral Hearing is concurrently filed with this Reply Brief.

I. Status of Rejections

In response to the Amended Appeal Brief filed December 12, 2007, the Examiner has maintained the following grounds for rejection:

A. Claims 39-53, 55-58, 61-62, 111-125, 127-130, 133-149, 151-154, and 157-158 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Japanese Patent Publication No. 4-1544408 (Japan '408), in view of Great Britain Patent No. 2,224,472 ("Great Britain '472"), Japanese Patent Publication No. 6-247,109 ("Japan '109"), alleged admitted prior art (specification page 3, lines 1-5)(“AAPA”), and optionally U.S. Patent No. 2,104,532 to Sommer (“Sommer”).

B. Claims 60, 132, and 156 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Japan '408 in view of Great Britain '472, Japan '109, AAPA and optionally Sommer, and further in view of European Patent Application No. 722,851 to Guspodin et al. ("Guspodin").

C. Claims 39-53, 55-58, 111-125, 127-130, 135-149, and 151-154 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sommer in view of Great Britain '472, AAPA, and optionally at least one of U.S. Patent No. 1,996,418 to Hargraves ("Hargraves") and Japan '109.

D. Claims 54, 126, and 150 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sommer in view of Great Britain '472, AAPA, and optionally at least one of Hargraves and Japan '109, and further in view of European Patent Application No. 565,270 to Himuro ("Himuro").

E. Claims 59-62, 131-134 and 155-158 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sommer in view of Great Britian '472, AAPA, and optionally at least one of Hargraves and Japan '109, and further in view of Guspidin.

F. Claims 135-141, 146, 149, 152, and 153 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 2,011,552 to Hoover ("Hoover") in view of U.S. Patent No. 4,446,902 to Madec et al ("Madec").

II. Response to Examiner's Arguments in the Answer

A. Hoover

In regards to Hoover, the Examiner asserts at pages 3-6 and 26-29 of the Answer that Hoover discloses the claimed limitation that "each substantially-continuous tread portion ends at an equatorial groove portion of a same transversal groove of an axially-opposed group of transversal grooves," as claimed in independent claim 135. Claim 135 also requires that:

- i) the transversal grooves are circumferentially distributed in groups alternately extending from the axially-opposed shoulder zones, and
- ii) the groups of transversal grooves define a plurality of substantially-continuous tread portions in the equatorial zone (emphasis added).

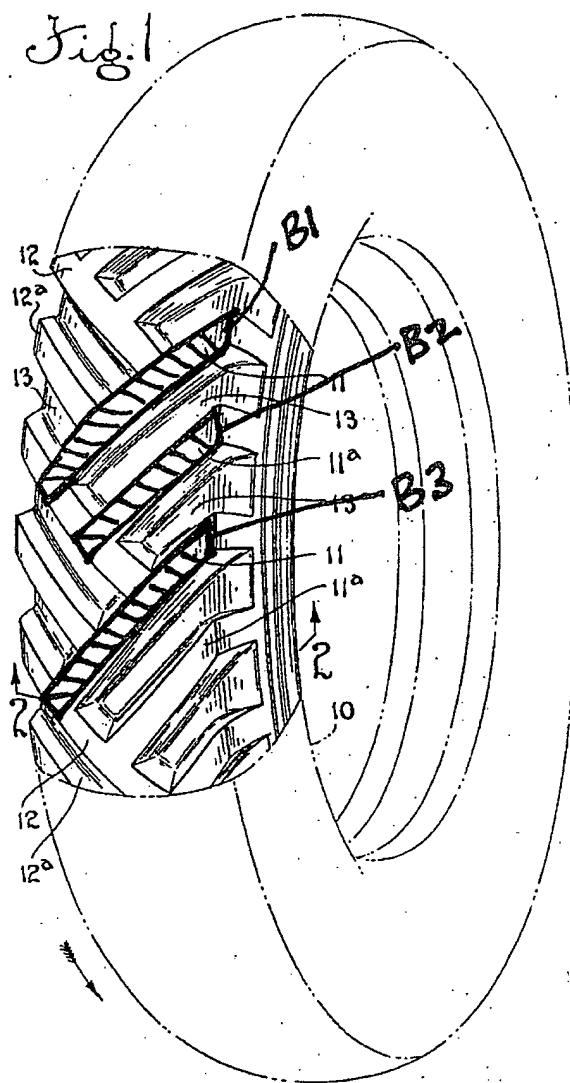
Thus, in order to meet the limitation that "each substantially-continuous tread portion ends at an equatorial groove portion of a same transversal groove of an axially-opposed group of transversal grooves," there necessarily must be:

- i) a plurality of transversal grooves circumferentially distributed in groups alternately extending from the axially-opposed shoulder zones, and

ii) a plurality of substantially-continuous tread portions in the equatorial zone defined by the groups of transversal grooves.

Hoover fails to disclose these features. On page 4 of the Answer, the Examiner shows a marked-up version of Figure 1 of Hoover. The Examiner's marked-up figure highlights some of the ribs and some of the grooves. The Examiner then alleges that Hoover would disclose groups of two transverse grooves and two corresponding ribs in each group. (Answer at page 5.)

The Examiner's presentation of what Hoover discloses is misleading not only because the ribs have been grouped without any basis, as already submitted in the Appeal Brief (see page 41), but also – and most importantly – because the rib grouping made by the Examiner disregards the above-mentioned requirements of claim 135, particularly that there must be "a plurality of substantially-continuous tread portions in the equatorial zone defined by the groups of transversal grooves." Because the claim requires a group (i.e. at least two) of transversal grooves the substantially-continuous tread portions identified by the Examiner must include more than just B1 and B2 as shown on page 4 of the Answer. The group must necessarily include three corresponding substantially-continuous tread portions or ribs, one rib (B2) between at least two of transversal grooves and the other two (B1, B3) on either side of each transversal groove, as shown in the marked-up Figure 1 of Hoover below.



Contrary to the analysis made by the Examiner, therefore, in Hoover's Figure 1 each plurality of transversal grooves defines three corresponding ribs B1, B2, and B3. Thus, either the third rib (B3) of Hoover does not end at the same transversal groove, as already submitted in the Appeal Brief, or Hoover does not disclose any plurality of substantially-continuous tread portions in the equatorial zone defined by a group of transversal grooves, but only two substantially-continuous tread portions B1, B2 defined by only one transversal groove (the groove in-between ribs B1 and B2). In either case,

Hoover does not meet at least one of the claimed limitations, and therefore independent claim 135 is allowable.

B. Japan '408

In regards to Japan '408, at page 32 of the Answer, the Examiner asserted, in response to Appellant's argument that the proposed modification of Japan '408 would critically alter the key features of the tire disclosed therein, that Japan '408 allegedly "attaches no importance and criticality to making the grooves 4 form wave shaped grooves 7 that cross the centerline in a zigzag manner." This allegation is contrary to the disclosure and teachings of Japan '408.

According to Japan '408, in fact, one of the key features of the disclosed invention is that the wave-shaped grooves 7 that cross the center line in a zigzag manner define block rows 5 at the left and right ends of the tread surface in a manner such that the inner-end sides of said block rows 5 cross one another at the center region in units of one or multiple blocks in the shapes of "Λ" in the tire's rotating direction (see claim 1 and description at page 6, last paragraph of the English translation of Japan '408). Therefore, contrary to what the Examiner alleges, making the grooves 4 form wave shaped grooves 7 that cross the centerline in a zigzag manner is an important and critical feature of the tire disclosed by Japan '408 so that the proposed modification to Japan '408 would critically alter the key features of the tire of Japan '408 rendering the same inoperable for its intended purpose.

The Examiner also alleged at page 33 of the Answer that "if Japan 408's wave shaped (zigzag) circumferential groove is omitted, Japan 408 would continue to

comprise alternating groups of parallel continuous grooves 4. Japan 408 tread would also continue to comprise blocks wherein the blocks on one side are connected to the blocks on the other side" (emphasis added).

This allegation is incorrect for two reasons. First, as noted above and as already argued in the Appeal Brief (see page 29-30), the omission of the wave shaped grooves 7 would imply the omission of an important and critical feature of the tire disclosed by Japan '408 altering its principle of operation. Second, the omission of the wave shaped grooves 7 would also imply the disappearance of the blocks (which must cross one another at the center region in units of one or multiple blocks in the shapes of "Λ" in the tire's rotating direction) which is another important and critical feature of the tire defined by claim 1 of Japan '408.

The blocks (i.e. tread portions delimited between consecutive grooves, both along the axial and along the circumferential direction) disclosed in Japan '408 are not continuous tread portions such as those illustrated by Great Britain '472, Japan '109, or Sommer, neither from a structural nor from a functional point of view. Therefore, one of ordinary skill in the art would have had no motivation to modify the tread pattern of Japan '408 as indicated by the Examiner since the proposed modifications are of features considered to be essential, such as the multiple parallel continuous grooves (4) running from the central portion to both shoulder portions on the tread and enclosing the rows of parallel blocks (5). Moreover, the Examiner's modification of Japan '408 is improper because it would change the principle of operation of a reference. The tire of

Japan '408 is specifically designed to have parallel continuous grooves which form block rows.

C. Sommer As Modified By Hargraves

The Examiner alleges at page 44 of the Answer that "Hargraves teaches alternating groups of inclined transversal grooves and suggests locating the ends [of] the inclined grooves of one group in Sommer's figure 8, 8a tread at the same distance from the longest groove of the axially opposed group." The Examiner also claims that both Hargraves and Sommer teach "blind" inclined grooves. (Answer at 44.)

The Examiner's reasoning is based on a reading of Hargraves that is contrary to the disclosure and teachings of Hargraves. Hargraves, in fact, expressly teaches that "The longest groove designated 17a, of each group connects with respective radial grooves 19 on opposite sides of the tread" (emphasis added; see Hargraves, page 1, right col., ll. 22-25) so that this V-shaped transversal groove 17a or the continuous zigzag shaped transversal groove 22 of the other embodiment disclosed axially crosses the entire tread band and does not end either at a predetermined distance from the equatorial groove portion of a longest transversal groove of the axially-opposed group of transversal grooves, nor within the equatorial zone.

Also, the reference made by the Examiner to "blind" inclined grooves amounts to an extrapolation of features out of their context – since, as said above, Hargraves requires the presence of V-shaped transversal grooves 17a or continuous zigzag shaped transversal grooves 22 axially crossing the entire tread band.

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Therefore, even by combining Sommer and Hargraves contrary to any motivation to do so, one of ordinary skill in the art would have never arrived at the claimed tire, since by applying the actual teachings of Hargraves, at best the tread of Sommer would be modified by forming V-shaped transversal grooves or continuous zigzag shaped transversal grooves axially crossing the entire tread band and constituting the longest transversal groove of each group of transversal grooves, contrary to the language of independent claims 39, 58, 111, 135 and 154.

III. CONCLUSION

To establish a *prima facie* case of obviousness, the Examiner must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). In view of the mischaracterizations of the cited references set forth in the Examiner's Answer and in the original rejections, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. For at least these reasons and the reasons given in Appellant's Appeal Brief filed on December 12, 2007, Appellant respectfully requests the Board to reverse the final rejection of claims 39-62 and 111-154 under 35 U.S.C. § 103(a). Please charge any additional required fees to our Deposit Account No. 06-0916.

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Respectfully submitted,

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Dated: May 13, 2008

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